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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dominique Loubinoux

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OWENS CORNING
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EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1786

NOTIFICATION DATE

DELIVERY MODE

04/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USIPDEPT@owenscorning.com

Office Action Summary	Application No. 10/577,939	Applicant(s) LOUBINOUX, DOMINIQUE	
	Examiner Cheryl Juska	Art Unit 1786	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 and 34-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 and 34-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed December 24, 2009 has been entered. Claims 17, 34 and 42 have been amended as requested. Claims 1-16 and 26-33 have been cancelled and new claims 45-47 have been added. Thus, the pending claims are 17-25 and 34-47.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-25 and 45-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended independent claim 17 and new claims 46 and 47 limit the mat to being in an uncompressed state. Applicant asserts said amendment is supported in the specification at page 5, line 31 - page 6, line 2 and Figures 1-3 (Amendment, page 5, 1st paragraph). The examiner respectfully disagrees.

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4. Specifically, the new limitation is a negative limitation which is not supported by the cited passage of the specification, which merely states “subjecting the web to a treatment for bonding the yarns together to form a deformable mat.” This recitation and the figures are not sufficient to provide support for the negative limitation of uncompressed. Note said “a treatment for bonding” is not exclusive of a compression step. MPEP 2173.05(i), *Negative Limitations*, states “Any negative limitation or exclusionary proviso must have basis in the original disclosure.” See *Ex parte Grasselli*, 231 USPQ 393. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Hence, the specification does not provide support for the concept of “uncompressed” and claims 17-25 and 45-47 are rejected as containing new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 17, 34, 42, and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 17, 46, and 47 are indefinite for the recitation “in an uncompressed state,” which is a phrase descriptive of a process step. Since applicant is claiming a product and not a process of making said product, the term becomes a relative term with respect to the thickness and/or density of the final product. As such, the term “uncompressed” renders the claim indefinite in that said term is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

8. Claims 34, 42, and 45 are rejected as indefinite for the recitation “wherein said mat possesses sufficient flexibility to be deposited inside a mold without forming pleats.” Said recitation is indefinite for its degree of relativity. Specifically, the degree of flexibility required to prevent forming pleats will depend in part upon the shape of the mold. For mats of like flexibility, a relatively planar mold will inherently produce fewer pleats in said mat than a heavily contoured mold. Hence, describing the mat’s flexibility in terms of the formation of pleats when deposited inside a mold is a relative limitation rather than an absolute or quantitative limitation.

Claim Rejections - 35 USC § 102/103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 17-24 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 20010032696 issued to Debalme et al. as set forth in section 6 of the last Office Action.

As described above, applicant’s new limitation that the mat of claim 17 is in an uncompressed state is descriptive of the process of making said mat. While Debalme clearly teaches bonding the mat by means of heat and compression, the final product of the reference can be described as “in an uncompressed state” in that, as a finished product, it is not in a state of

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being compressed by force. Additionally, note that while Debalme bonds by compression, applicant has not shown that the prior art has properties of compression (e.g., thickness, density, etc.) outside of the scope of applicant's claimed final product. Hence, said amendment is insufficient to overcome the standing rejection.

Claim Rejections - 35 USC § 103

11. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Debalme reference as set forth in section 7 of the last Office Action.

Applicant has not amended claim 25. As such, said rejection stands.

12. Claims 34-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Debalme reference as set forth in section 8 of the last Office Action.

Applicant has amended independent claims 34 and 42 with the limitation "wherein said mat possesses sufficient flexibility to be deposited inside a mold without forming pleats, and wherein said mat has a porosity ranging from 65-80%." However, said amendment is insufficient to overcome the standing rejection.

First, regarding the porosity limitation, said limitation was previously addressed in the rejection of claim 17. To reiterate, although the Debalme reference does not explicitly teach the porosity property, it is reasonable to presume that said porosity is met by the Debalme invention when bonded by stitchbonding means. Support for said presumption is found in the use of similar materials (i.e., mat formed of web of commingled yarns of a reinforcing glass fiber and a thermoplastic fiber) and in the similar production steps (i.e., depositing the yarns into a web and

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bonding said web into a coherent mat) used to produce the mat. The burden is upon applicant to show otherwise.

Secondly, regarding the flexibility limitation, it is argued said limitation is relative one which cannot be relied upon for patentability. Additionally, it would have been obvious to a skilled artisan to produce the mat with sufficient flexibility as claimed since the Debalme invention is intended for use in molding. Therefore, claims 34-44 stand rejected.

13. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Debalme reference.

New claim 45 limits the mat of claim 17 to possessing sufficient flexibility to be deposited inside a mold without forming pleats. As such, claim 45 is rejected for reasons analogous to those set forth above with respect to claims 34 and 42.

New claims 46 and 47 limit the mats of claims 34 and 42, respectively, to being in an uncompressed state. As such, said claims are rejected for reasons analogous to those presented above in the rejection of claim 17.

Response to Arguments

14. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

15. Applicant traverses the rejection of claim 17 by asserting the mat of Debalme is not in an uncompressed state since the reference teaches bonding by heat and compression (Amendment, page 6, 2nd paragraph - page 7, 3rd paragraph). However, as discussed above, the limitation "in

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an uncompressed state” with respect to the claimed final product is met by Debalme’s *finished product* not being in an active state of compression, despite its being made by a compression step.

Additionally, if said limitation is read as a method limitation, then said limitation is given patentable weight only to the extent that it materially affects the structure of the final product. While bonding by compression may affect the final thickness and/or density of the mat, applicant’s claim does not limit these features. As such, any effects of bonding by compression can be interpreted as being relative to bonding by other means. Thus, applicant’s argument is found unpersuasive and the above 102/103 rejection of claims 17-24 is maintained.

16. Regarding the obviousness rejection of claims 34 and 42, applicant asserts the Debalme reference fails to teach “light” bonding to preserve deformability and instead teaches the mat is a “rigid product” (Amendment, paragraph spanning pages 7-8). This argument is unpersuasive since Debalme’s “rigid” sheet is but one embodiment of the invention. The reference clearly teaches the mat may be formed into cut sheets *or* wound onto rolls (abstract and section [0015]). As such, at least in the embodiment wherein the mat is formed into rolls, said mat must have some degree of flexibility. Additionally, it is noted that applicant’s recitation of flexibility and Debalme’s recitation of rigidity are relative descriptions. Since the mats of Debalme are employed for the same end-use (i.e., molding), it is reasonable to presume that said mats have sufficient flexibility to be suitable for molding processes. Furthermore, a skilled artisan would readily understand the degree of flexibility required for mats employed in molding, wherein said required flexibility is somewhat dependent upon the degree of contour of said mold. Hence, applicant’s arguments are found unpersuasive and the above rejection is maintained.

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17. With respect to the rejection of claim 25, applicant reiterates the arguments against the rejection of claim 17 (Amendment, page 8, 3rd paragraph - page 9, 1st paragraph). Since said arguments have been previously found unpersuasive, the rejection of claim 25 also stands.

18. Regarding the rejection of claims 34-44, applicant traverses the examiner's Official Notice by submitting "that stitchbonding a mat in order to achieve both a desired deformability for use in a molding process and a porosity between 65-85% is not well known" (Amendment, page 10, 1st paragraph). In response, it is asserted that that applicant's motivation to stitchbond (i.e., in order to achieve both deformability and porosity) is not the fact relied upon by the examiner in her Official Notice. Specifically, it was stated "stitchbonding is a well known method of integrating a web, including fiberglass-based webs, to enhance the mat's dimensional stability." Hence, the examiner need not establish stitchbonding "to achieve both a desired deformability for use in a molding process and a porosity between 65-85%" is well known. Applicant is reminded that to adequately traverse such a finding of Official Notice, applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the specific noticed fact is not considered to be common knowledge or well-known in the art. Despite applicant's adequate traversal of the examiner's Official Notice, US 2005/0118390 issued to Wagner et al. is cited for its teaching of glass strand stitchbonded mats and US 6,407,018 issued to Zafiroglu is cited for its teaching of stitchbonding nonwoven fabrics which are suited for thermoforming operations. Therefore, applicant's traversal is found unpersuasive and the above rejection stands.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner can be emailed at cheryl.juska@uspto.gov or the examiner's supervisor, D. Lawrence Tarazano can be reached at 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Juska/
Primary Examiner
Art Unit 1794

cj
April 12, 2010